

ESTTA Tracking number: **ESTTA582065**

Filing date: **01/15/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198552
Party	Defendant Fifty-Six Hope Road Music Limited
Correspondence Address	PAUL A BOST SHEPPARD MULLIN RICHTER HAMPTON LLP 1901 AVENUE OF THE STARS , SUITE 1600 LOS ANGELES, CA 90067 UNITED STATES pbost@sheppardmullin.com, jpietrini@sheppardmullin.com, congsing@sheppardmullin.com
Submission	Reply in Support of Motion
Filer's Name	Paul A. Bost
Filer's e-mail	pbost@sheppardmullin.com
Signature	/s/ Paul A. Bost
Date	01/15/2014
Attachments	56 Hope Road's Reply Brief ISO MTN to Suspend Proceedings.pdf(322867 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>In re Matter of Serial No. 77/549,263 <i>for the mark:</i> ONE LOVE</p> <p>RAISING CANE’S USA, LLC,</p> <p>Opposer,</p> <p>vs.</p> <p>FIFTY-SIX HOPE ROAD MUSIC, LTD.,</p> <p>Applicant.</p>	<p>Opposition No. 91-198552</p> <p>APPLICANT AND PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.177(a)</p>
<p><i>In re Matter of Registration No. 3,033,511 for the mark:</i> ONE LOVE</p> <p>FIFTY-SIX HOPE ROAD MUSIC LIMITED,</p> <p>Petitioner,</p> <p>vs.</p> <p>RAISING CANE’S USA, LLC,</p> <p>Registrant.</p>	<p>Cancellation No. 92-053461</p>

In its opposition to applicant and petitioner Fifty-Six Hope Road Music Limited’s (“Petitioner”) motion to suspend, opposer and registrant Raising Cane’s USA, LLC (“Registrant”) does not dispute that Petitioner’s recently filed civil action against Registrant will be dispositive of – much less have a bearing on – the issues before the Board. Likewise, Registrant does not dispute that suspension of the matter is in the interest of judicial economy, namely, the United States District Court’s decision will

resolve claims relating to use of the ONE LOVE mark, not just registration; it will be binding on the Board under the doctrines of res judicata and collateral estoppel, whereas the Board's decision will not necessarily be afforded preclusive effect; and suspension of the matter allows the parties to fight their proverbial battle on one front, not two. Having admitted the above, Registrant cannot reasonably contend that Petitioner's motion should not be granted and the parties' consolidated proceedings before the Board not be suspended. Additionally, even if Petitioner has evaded discovery in this matter as Registrant argues (it has not), Registrant has not cited any authority establishing that any such alleged evasion is relevant to the question of whether the consolidated proceedings should be suspended. Furthermore, the entire premise of Registrant's argument is misguided: Petitioner has filed affirmative claims of infringement against Registrant in United States District Court not to, as Registrant has alleged, "indefinitely delay this matter" but, instead, to come to a final resolution of the parties' entire dispute concerning registration and use of the ONE LOVE mark, which only a United States District Court has the authority to render. Notably, Registrant has expanded its use of ONE LOVE since the dispute between the parties arose, and such use will be addressed in the civil action, not the consolidated proceedings.

Because this reply addresses arguments and facts raised by Registrant for the first time in its opposition brief, Petitioner respectfully requests that the Board consider its reply brief.

A. Registrant Does Not Dispute that Petitioner's Claims in its Recently Filed Civil Action Will Be Dispositive of the Issues the Parties Have Raised Before the Board

If not *expressly*, Registrant, at least, *tacitly* admits that the issues raised by the parties' in the consolidated proceedings are encompassed within those raised by

Petitioner in the civil action: “[Petitioner’s] allegations in its district court complaint against [Registrant], styled *Fifty-Six Hope Road Music, Ltd. v. Raising Cane’s USA, LLC*, No. 1:13-cv-13110, are rooted in its claims before the Board.” See Docket No. 39, Registrant’s Opposition (“Reg. Opp.”), page 2. This is the key consideration and alone is reason for the Board to grant Petitioner’s motion and immediately suspend the consolidated proceedings.

B. Suspension of the Consolidated Proceedings is Undoubtedly in the Interest of Judicial Economy

Registrant also does not dispute that suspension of the consolidated proceedings is in the interest of judicial economy. Whereas the consolidated proceedings are limited to the parties’ respective rights to register the ONE LOVE trademark, the civil case will result in the adjudication of the parties’ rights to register *and use* the ONE LOVE trademark, among other issues. Additionally, the judgment in the civil case is binding on the Board, while the opposite is not necessarily true. Under these circumstances, it is a waste of judicial resources for the parties to fight their battle on two fronts when all issues can be addressed by the court in the civil case.

C. Suspension of the Consolidated Proceedings Will Speed, Not Delay, Resolution of the Parties’ Dispute

Registrant contends that Petitioner’s motion should be denied because suspension of this matter will “further delay resolution of the parties’ trademark dispute.” See Reg. Opp., page 2. Registrant’s argument is meritless.

First, and as stated above, the Board does not have statutory authority to fully resolve the parties’ trademark dispute. Instead, this authority resides solely with the United States District Court. The parties’ dispute includes their respective rights to use the ONE LOVE mark, and full resolution thereof can only be accomplished in the civil

action. Likewise, by filing the civil action, Petitioner is not attempting to “short-circuit the administrative tribunal that has already achieved jurisdiction over the issues.” See Reg. Opp., page 4, *citing McCarthy on Trademarks and Unfair Competition* § 30:110 (4th ed. 2010). On the contrary, the Board does not have jurisdiction over the issue of use of the ONE LOVE trademark, much less the other affirmative claims for relief alleged by Petitioner against Registrant.¹

Second, the consolidated proceedings are not – as Registrant contends – “at the late stages of the Board proceeding.” See Reg. Opp., page 4. On the contrary, Registrant itself admits that discovery in the consolidated proceedings has not concluded. The parties have not served pre-trial disclosures and the first testimony period in the consolidated proceedings has not opened. Thus, the consolidated proceedings are not in a late stage and the Board’s adjudication of the parties’ claims is not imminent.

Third, Petitioner has not delayed and is not seeking to delay adjudication of the parties’ dispute or deposition of its witnesses. Registrant’s continued allegations of delay on the part of Petitioner are belied by the fact that Registrant has never filed a motion to compel the deposition of any of Petitioner’s witnesses. In fact, Petitioner filed the only proper motion to compel in this case, which was prompted by Registrant’s own

¹ Although Registrant cites to *Dunn Computer Corp. v. LoudCloud, Inc.*, 133 F. Supp.2d 823 (E.D. Va. 2001) and *Circuit City Stores, Inc. v. Speedy Car-X, Inc.*, 35 U.S.P.Q.2d 1703 (E.D. Va. 1995), it is unclear for what purpose. Registrant has not provided pin cites for the citations. Also, both cases address whether pre-litigation communications and cease and desist letters suffice to create a justiciable case or controversy that can ground a declaratory judgment action. See *Dunn*, 144 F. Supp.2d at 825; *Circuit City*, 35 U.S.P.Q.2d at 1703. This is not the case here. Petitioner’s civil action does not seek declaratory relief, but affirmative relief based on its allegation that Petitioner’s use of the ONE LOVE mark infringes its rights.

failure to comply with its discovery obligations and the balance of which was granted by the Board. See Docket Nos. 24 and 30. Furthermore, Registrant's claim that Petitioner is delaying resolution of the parties' dispute is belied by its own actions. This case was filed in late December 2010 before the statutory period expired for Registrant to claim that its registration of ONE LOVE was incontestable. Yet, Registrant tried to sneak in its incontestability affidavit, which was rightfully rejected by the Board. See Docket No. 17, fn. 2. Registrant also filed a wholly unsupported motion for summary judgment on August 19, 2011 (see Docket No. 6), which the Board denied on July 6, 2012. See Docket No. 17. Registrant's tactics delayed the Board proceedings from the start. Additionally, after Petitioner filed the civil action, Registrant filed a competing civil action in the Middle District of Louisiana despite proper jurisdiction and venue over the federal action in Massachusetts, which is likely to further delay resolution of the parties' dispute. Therefore, Registrant has only itself to blame if it does not believe adjudication of the parties' dispute has moved forward fast enough.

Furthermore, Petitioner made available for deposition both witnesses whose depositions were noticed by Registrant: Michael Conley and Petitioner's 30(b)(6) witness(es). Registrant fails to note that Petitioner only requested that the deposition of Mr. Conley and Petitioner's 30(b)(6) witness(es) occur beyond the limited period allowed by the Board due to the surgery of Petitioner's counsel, and that Petitioner gladly stipulated to the extension of this deadline given those circumstances. See Reg. Opp., Exhibit 4, Email from Paul Bost to S. Lloyd Smith, October 9, 2013. Registrant

took the deposition of Mr. Conley on December 3, 2013.² Registrant's contention that Mr. Conley was only informed of the date of his deposition a few days before is misleading and irrelevant. Mr. Conley testified that he had been made aware that his deposition was requested in the consolidated proceedings on a number of occasions prior to his deposition, and, in any event, Mr. Conley appeared at his deposition at the time and place agreed to by the parties. See **Exhibit A** hereto, which are true and correct copies of pages from Mr. Conley's deposition transcript relating to the scheduling of his deposition. Although the deposition of Petitioner's 30(b)(6) witness(es) was scheduled, it was ultimately taken off the calendar due to Petitioner's filing of the civil action in question.

Next, Registrant's claim that Petitioner filed the civil action to delay resolution of the parties' dispute is, on its face, nonsensical. As explained above, the parties' dispute can *only* be holistically resolved by means of a civil action. If Registrant wishes to take the deposition of Petitioner, it will have that opportunity as part of the civil action.

² Registrant misleadingly claims that Petitioner "ignored all communications from [Registrant's] counsel regarding deposition logistics." See Reg. Opp., p. 3. The very emails that Registrant uses to support this position clearly request Petitioner's response only in the event Petitioner wished to change any the accommodations Registrant was making for the deposition. See Reg. Opp., Exhibit 6. Being fine with Registrant's proposed accommodations, Petitioner had no reason to respond. The day before the deposition of Mr. Conley, Registrant's counsel commenced a phone-calling campaign to confirm that Mr. Conley's deposition was going forward as scheduled (despite the fact Registrant's counsel had been informed by Jill Pietrini, Petitioner's counsel, the prior week that it was going forward). Because Ms. Pietrini and Mr. Bost were out of the office at hearings that morning, they did not receive Registrant's counsel's phone calls, who commenced querying their respective legal assistants about their travel schedules instead of simply trusting the earlier representation of Ms. Pietrini, which they had no reason to doubt and which was validated by Mr. Conley's appearance at his scheduled deposition. See Reg. Opp., Exhibit 7, Email from Paul Bost to S. Lloyd Smith, December 2, 2013.

Finally, Registrant has not explained how any alleged delay on the behalf of Petitioner regarding the deposition of its 30(b)(6) witness is remotely relevant to the issue of suspension. Even if Registrant's allegations that Petitioner has evaded discovery are true (they are not), Registrant has not cited any authority stating that alleged discovery malfeasance is relevant to the issue of suspension.

D. Conclusion

For the reasons stated above and in its motion, Petitioner respectfully requests that these consolidated proceedings be suspended pending the disposition of Petitioner's recently filed civil action.

Respectfully submitted,

Dated: January 15, 2014

By: /s/Jill M. Pietrini
Jill M. Pietrini
Paul A. Bost
SHEPPARD MULLIN RICHTER &
HAMPTON, LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067
Attorney for Registrant/Petitioner
Fifty-Six Hope Road Music Limited

CERTIFICATE OF FILING

I hereby certify that **APPLICANT AND PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.177(a)** is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 15th day of January, 2014.

/s/Lynne Thompson
Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that **APPLICANT AND PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.177(a)** is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to: S. Lloyd Smith, Esq., BUCHANAN INGERSOLL & ROONEY, PC, P.O. Box 1404, Alexandria, VA 22313-1404, with a courtesy copy via electronic mail to lloyd.smith@bipc.com, on this 15th day of January, 2014.

/s/Lynne Thompson
Lynne Thompson

SMRH:415539479.1

ATTORNEYS' EYES ONLY

Conley, Michael

December 3, 2013

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Matter of Serial No. Opposition No.:
77/549,263 91198553
for the mark: ONE LOVE
RAISING CANE'S USA, LLC,

Opposer,
vs.

FIFTY-SIX HOPE ROAD MUSIC
LIMITED,

Applicant.

_____/

In re Matter of Cancellation No.:
Registration No. 3,033,511 92053461
for the mark: ONE LOVE
FIFTY-SIX HOPE ROAD MUSIC
LIMITED,

Petitioner, ATTORNEYS' EYES ONLY
vs.

RAISING CANE'S USA, LLC

Registrant.

_____/

DEPOSITION OF MICHAEL CONLEY
Taken on Tuesday, December 3, 2013
At Crown Plaza Airport

14670 Duval Road
Jacksonville, Florida 32208
From 9:44 a.m. to 2:33 p.m.

Reported by: Elaine M. Wall, FPR

Henderson Legal Services, Inc.

202-220-4158

www.hendersonlegalservices.com

1 **A This was in Las Vegas, yes.**

2 Q Did you buy any food at the restaurant?

3 **A I think I did. The food was good**
4 **actually.**

5 Q Do you remember when this was that you
6 purchased the shirt?

7 **A It couldn't have that long ago. And I**
8 **don't know if I was out there for the MAGIC show,**
9 **which, again, kind of all run together being that**
10 **you do them so often or this other litigation that**
11 **we were based out there for, which was that AVELA**
12 **case. I'm going to give you a complete guess, 2010**
13 **maybe.**

14 Q All right. After that, did you have any
15 involvement in this case?

16 **A No. No, I remember going in, buying it,**
17 **and sending the shirt and the receipt that I bought**
18 **it to Jill Pietrini's office.**

19 Q And when was the next time you were
20 spoken to about this case or had any involvement in
21 this case?

22 And I'm not asking you, obviously, for

1 attorney/client privileged conversation.

2 **A Sure. I understand.**

3 **You know, I don't know, maybe, maybe it**
4 **was a year ago, if this was going on, "Mike, you**
5 **might have to be deposed in this case." And then I**
6 **never heard anything back on it. And then Tim had**
7 **said something to me.**

8 MR. ERVIN: Well, you can't talk about
9 what you and I talked about.

10 **THE WITNESS: Okay. Well, maybe a couple**
11 **of times in the last year, that, "ey, you might**
12 **have to get deposed in this case." But I**
13 didn't -- there was a sudden one for today.
14 Like I said, I knew yesterday to come here for
15 this today.

16 BY MR. SMITH:

17 **Q And before that, when was the last time**
18 **somebody has asked you about this case or told you**
19 **you might be deposed?**

20 **A Let me see. It was after we sold the**
21 **company. It was in the last year. I don't know,**
22 **maybe four months ago, something like that.**